



The Intellectual Property Law Section of
the State Bar of California presents the
32nd Annual Intellectual Property Law Institute

KSR v. Teleflex, Inc.

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How Do We Practice Under KSR?

- In KSR the Supreme Court identifies four specific Federal Circuit errors in applying the TSM Test:
 - In seeking rational for combination or modification of elements of cited art the Examiner may look not only to the problem to be solved by the inventor, but any known problem or need for the combination or modification
 - One of ordinary skill in the art may be led by art other than that which solves the problem
 - A claim can be obvious because the combination or modification was obvious to try
 - Common sense, guided by either hindsight or other factors properly plays a role in the obviousness analysis



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How Do We Practice Under KSR (cont)?

- There is a shift against patentability, it is now easier under the decision of KSR for the Examiner to make ad hoc obviousness rejections through the use of an expansive and flexible new non-TSM standard
- Graham v. John Deere still controls therefore the secondary indicia established under that case is still relevant
- The Examiner must establish “an apparent reason to combine. . . known elements.” AND must expressly articulate the underlying rational for this “apparent reason”.



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How Do We Practice Under KSR (cont)?

- *Graham v. John Deere*, 383 U.S. 1 (1966)
 - Non-obviousness is a new third statutory requirement for patentability.
 - Scope and content of prior art are determined
 - Differences between the prior art and the claims at issue are ascertained
 - The level of ordinary skill in the art is determined
 - Secondary considerations (“such as” commercial success, long-felt but unsolved needs, failure of others, etc.) “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.”
 - PTO instructed to “strictly adhere” to 1952 Act.



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How Do We Practice Under KSR (cont)?

- A patentee should not accept any conclusion of obviousness without “some articulated reasoning with some rational underpinning”.
- A statement by the Examiner that the references individually teach ALL the claimed limitations is improper
- Attack rejections with rationale on their merits
- It is more critical than ever that unexpected and surprising results in the invention compared to the art must be highlighted to the Examiner
- Declaration practice will be more important than ever!
 - Take the initiative to establish through the use of declarations the INVENTORS perceptions and actual knowledge of the art at the time of his/her invention
 - File these declarations during the course of prosecution to educate the Examiner and more importantly establish the state of the art
 - Note that the Examiner’s today are relatively inexperienced with affidavit and declaration practice



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How Do We Practice Under KSR (cont)?

- Tell the world your inventor's story!
- Speak to how the invention evolved from the solution of the inventor's problem
- Present the “common sense” differences between the prior art and the claimed invention
- Establish through your story the level of skill in the art!
- Remember that the USPTO is NOT A COURT
- The USPTO examines patent applications in a prospective manner in an ex parte proceeding with a limited evidentiary basis
- The Patent Examiner utilizes a limited data base under tight time constraints with even more limited facilities and guidance in view of KSR



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How Do We Practice Under KSR (cont)?

- In the preparation of your patent THINK LIKE A LITIGATOR!
 - Collect objective real world evidence of the non-obviousness of your inventor's concept
 - Document commercial success, the displacement of prior solutions, praise from the industry
 - MAKE THE PATENT EXAMINER YOUR JURY



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How Do We Practice Under KSR (cont)?

- During Patent prosecution
 - Focus on the Interdependency of individual features in each claim clearly establish that a claimed combination is NOT a predictable use of prior art elements in their established functions
 - Don't forget the 'teaching away' arguments that have been so successful under John Deere
 - Do not let the Examiner off the hook in their duty and requirement under KSR to provide a rationale or underpinning!
 - Highlight during prosecution unexpected results and/or commercial success through the use of affidavits from the inventors



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How Do We Practice Under KSR – SUMMARY (cont)

- We as representatives of the Applicants must tell their story in a way that will convince the Examiner of the unique and necessary solution that has come from the efforts of the inventor
- Efforts that resulted in a new and NON OBVIOUS solution to the long held problem
- We must present to the Examiner facts documenting a combination of elements is more than a mere predicable combination of functions
- We will incorporate into our applications explanations of unpredictability and unexpected results
- We will describe secondary factors
- During prosecution we will not accept rejections without clear and convincing rationale from the Examiners and we will
- Provide evidence by way of declarations from our inventors as to the state of the art and their solutions